

### REMARKS

We have addressed the Examiner's objections to the Abstract and the Specification. We have also amended independent claim 5 to include the features recited in dependent claims 10 and 11 (now cancelled).

#### Prior Art Rejections

##### *Curiel (U.S. 4,652,727)*

Examiner has rejected claims 5-12 under 35 U.S.C. 102(b) as being anticipated by Curiel (U.S. 4,562,727).

We submit that Curiel does not describe or suggest an untethered, active instrument comprising a power supply including one or more solar cells, one or more light sources, and a wireless communication device. The examiner contends that the language in the preamble of independent claim 5 merely recites an intended use and does not distinguish the applicant's invention over the prior art, if that prior art has a structure capable of performing that intended use. Curiel describes a rechargeable solar battery for use in a number of different devices including a flashlight (Fig. 10) and a portable radio (Fig. 9). Curiel's flashlight, however, is not wireless and does not include an infrared interface for allowing communication between the instrument and the navigation system. Furthermore, neither Curiel nor the other references cited against the applicant suggest making the device wireless. It would therefore not be obvious to one skilled in the art to modify a rechargeable flashlight in order to allow for communication with the flashlight; it would be even less obvious to make that communication link wireless. Furthermore, Curiel neither describes nor suggests modifying his portable radio to include one or more light sources that allow for determining the position of the active instrument.

*Bucholz (U.S. 5,891,034) in view of*

*Bucholz (U.S. 6,490,467), further in view of*

*Koeda et al. (U.S. 5,924,978), further in view of*

*Curiel (U.S. 4,562,727)*

Examiner has further rejected claims 5-16 under 35 U.S.C. 103(a) as being unpatentable over Bucholz (U.S. 5,891,034, hereafter Bucholz '034) in view of Bucholz (U.S. 6,490,467, hereafter Bucholz '467), further in view of Koeda et al. (U.S. 5,924,978), further in view of Curiel.

The Examiner acknowledges that Bucholz '034 fails to disclose an autonomous (untethered) probe with a self-contained power supply driven by a solar cell for recharging a storage unit. The Examiner cites Bucholz '467 as disclosing an untethered battery-operated localization frame for ease of use, and an optical probe as an example of a localization frame (top of page 5 of the office action). We have reviewed the Bucholz '467 patent including the sections referenced by the Examiner (i.e., Figs. 11, 11A, 13A-13I and cols. 15-16) and see nothing that supports the Examiner's conclusion. Indeed, Fig. 11 shows both the reference frame 122 and the optical probe as being tethered and connected by cables. Bucholz'467 states:

Also connected via the break out box 118 is a reference frame assembly 120 including a reference frame 122 with cable connected to the break out box 118, a vertical support assembly 124, a head clamp attachment 126 and a horizontal support assembly 129. Optical probe 164 (which is a localization frame) is also connected via cable to the digitizer control unit 114 via the break out box 118.

We also see nothing that suggests that his localization frame is battery-operated. We submit therefore that even if a person of skill in the art would combine the teachings of Bucholz '034, Bucholz '467, Koeda and Curiel in the manner proposed by the Examiner, that person would not arrive at the invention recited in applicants' claims. For these reasons alone, we submit that independent claims 5, 14 and 16 are patentable over the references cited by the Examiner.

Applicant : Manfred Schmid et al.  
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Filed : August 31, 2001  
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We also submit that because claims 6-9, 12 and 13 depend from claim 5 and claim 15 depends from claim 14, these dependent claims are patentable for at least the same reasons that claims 5 and 14 are patentable.

Enclosed is a Petition for Three Month Extension of Time fee with a check for \$475.00 for the required fee. Also enclosed is a Notice of Appeal with a check for \$165.00 for the required fee. Please apply any other charges or credits to deposit account 06-1050, reference 07508-033001.

Respectfully submitted,

Date: \_\_\_\_\_

*May 7, 2004*

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